

RECEIVED  
CENTRAL FAX CENTER

MAR 19 2007

## REMARKS

Reconsideration of the above-identified patent application, as amended, is respectfully requested.

Claims 11 and 16 have been objected to since "the measuring beam" lacks antecedent basis. Therefore, both claims have been amended by adding the additional step of providing a measuring beam.

Claim 20 has been objected to since the device claim 20 depends from the method claim 11. Claim 20 has therefore been amended to change the claim to a method claim with claim now reciting a method according to claim 11 comprising "the further step of providing an optical measuring device . . ."

The claims have been rejected under 35 USC 101 since the claims do not recite a useful, concrete and tangible result. Referring to the second paragraph of the application, there is discussed the desirability of calculating the position of the tool for machining purposes. At the moment the beam is interrupted, the current position of the tool is detected so as to determine the current position of the tool. This allows for the machining to continue. Otherwise, the control system would not know the location of the tool to control future machining operations.

The invention possess a "real world" value in a manufacturing environment where machine tools are utilized, as opposed to subject matter that represent nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-98 \*\*> (1966); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). The knowledge of the position of

Amendment Response  
Serial No. 10/784,069 Group Art Unit 2877  
Atty. Docket No. 16589-4  
Page 5 of 7

a tool in a machine tool is essential for the operation of the machine tool and also for the result of a machining process, i.e. for the work piece produced under utilization of the method of the invention.

The present disclosure contains concrete indications of the practical application for the claimed invention: "The object of the present invention is to provide a solution to avoid the interfering influences of (air-contamination) particles situated in the region of a rotationally drivable tool to be measured when determining the position of the tool in a machine tool." (see 2<sup>nd</sup> page, 1<sup>st</sup> para of the originally description)

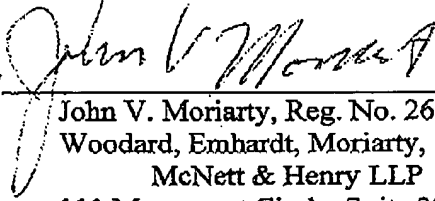
This statement explains the purpose of the invention. This statement also enables one ordinarily skilled in the art to understand why the claimed invention is useful. The result of the inventive method as presently claimed provides an indication to the worker where the tool in the machine tool is positioned. This indication can also be used in the (electronic) control system of the machine tool to initiate further processing steps carried out on a work piece in the machine tool. In the sense that it has an impact on/is used in the manufacturing process of a work piece in a machine tool, it is also tangible.

In view of the above, applicant has amended the independent claims 16 and 20 to recite the method of determining the position of a rotational drivable tool used in machining so that the position may be used in continued machining. It is believed that this is a useful and tangible result, is inherent description contained on pages 1 & 2 of the application and therefore qualifies under 35 USC 101.

In view of the above, it is believed the application is in condition for allowance and such action by the Examiner is respectfully requested. If the Examiner has further questions or issues concerning the enclosed, the undersigned is available to discuss the matters.

Respectfully submitted,

By



John V. Moriarty, Reg. No. 26,207  
Woodard, Emhardt, Moriarty,  
McNett & Henry LLP  
111 Monument Circle, Suite 3700  
Indianapolis, Indiana 46204-5137  
(317) 634-3456